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## **REMARKS**

### **Summary**

Claims 1-16 are pending in the present application. Claims 1, 7-9 and 13 are objected to due to certain informalities. Claims 9-16 are rejected under 35 U.S.C. §112, ¶2, as being indefinite.

By this amendment, claims 1, 2, 7-10, 13, and 14 are amended, and claims 17 and 18 are added. In particular, claims 1, 7-9 and 13 are amended to correct the informalities. Further, claim 9 is amended to correct the lack of antecedent basis and claim 13 is amended to correct the ambiguity. Accordingly, Applicant submits claims 9-16 are allowable under 35 U.S.C. §112, ¶2. Claims 17 and 18 are added to more distinctly claim and particularly point the present invention.

As for the prior art rejections, claims 9 and 10 are rejected under 35 U.S.C. §102(b) as being anticipated by Peterson (U.S. Pat. No. 4,328,767). Additionally, claims 1-8 and 11-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson '767.

### **Overview of Peterson '767**

While Peterson '767 discloses a retractable leash collar, it is of significantly different construct than the present invention. As shown in figure 1 of Peterson '767, a single retractor mechanism 15 for leash 16 is mounted on collar 10 adjacent to the opposite end of buckle 11. Retractor mechanism 15 is located on the underside of the pet's neck due to the weight of retractor 15 and associated components. When handle 20 is grasped and pulled, collar 10 is configured so as to attempt to prevent rotate around the pet's neck. (See, Peterson '767 at col. 2, lines 26-49) By the inventor's own admission in a later issued patent, the rotation problem was not solved. (U.S. Patent No. 5,816,198 to Peterson) Additionally, retractor mechanism 15, when in its unextended position, houses most of the length of leash 16. (See, Peterson '767 at col. 2, lines 36-40)

There are a number of practical problems with the retractable leash collar of Peterson '767. The Peterson '767 device results in a retractor mechanism that is big, bulky, heavy and obtrusive to the pet. Also, due to the excessive weight of retractor mechanism 15, it is not useful for smaller pets. Given the position of the retractor mechanism at the bottom of the pet's neck, guide rings 17 and 18 are required along collar 10. This results in a significant potential for snagging of leash 16 and the fur of the pet. Further, as explained in Peterson '198, the collar

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also suffered from rotation problems.

Additionally, by positioning retractor mechanism 15 on the underside of collar 10, leash 16 runs along the side of collar 10. When leash 16 is extended, this causes a disfiguring force on collar 10 that, if unchecked, will tighten collar 10 around the pet's neck. To prevent the tightening, Peterson '767 uses stiffening member 25 on collar 10. (See, Peterson '767 at col. 3, lines 51-53. However, stiffening member 25 does not conform to the contour of the pet leading to wear and chafing of the pet's fur and skin.

**Rejections Under 35 U.S.C. §102**

Claims 9 and 10 are rejected as being anticipated by Peterson '767. Claim 9 has been amended to more distinctly claim the means for retracting as being located on the upper side of the means for restraining. In contrast, retractor mechanism 15 of Peterson '767 is located on the under side of collar 10.

Turning to claim 10, handle 20 of Peterson '767 is comprised of hollow plastic shells 41 and 42 which are "held in assembled relation" by screw 46. Handle 20 would fall apart and be rendered useless if screw 45 were removed. (See, Peterson '767 at col. 3, lines 10-19 and figures 3-4) Thus, handle 20 is not "detachably coupled together" as screw 45 is not configured to be removed during use of the collar device. Moreover, handle 20 is ellipsoidal shaped and not a loop as recited in claim 10 as amended. Of note, hand loop 19 of Peterson '767 is unitary in construction and not detachable.

**Rejections Under 35 U.S.C. §103**

With respect to the obviousness rejections of claims 1 and 13, the Examiner asserts that it would have been obvious to add a second retraction member, a second flexible elongated member, and the second elongated member being coupled between the second end of the handle and the second retraction member.

The Examiner cites *St. Regis Paper Co. v. Bemis*, 549 F.2d 833, 193 USPQ 8 (7<sup>th</sup> Cir. 1977), without recitation to any particular page, for the proposition that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to supply a secondary of the essential working parts of the device, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. While this is a 7<sup>th</sup> Circuit case and thus not controlling, no such rule of law is stated in the case. In fact, *St. Regis Paper* applies a test for nonobviousness that is no longer applicable. The 7<sup>th</sup> Circuit court in *St. Regis Paper* held that the patentee is only entitled to a patent when

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combining old elements if the old elements create a synergistic combination. *St. Regis Paper*, 549 F.2d at 838-39. Although it is not clear if the Examiner is relying upon this holding, it is not the rule of the Federal Circuit, which has dismissed references to "synergism" as a requirement for patentability requirement as being unnecessary and confusing. *Chore-Time Equip., Inc. v. Cumberland Corp.*, 713 F.2d 774, 781 (Fed. Cir. 1983).

Additionally, in contrast to the assertion of the Examiner, the recited limitations are not simply duplication of essential working parts. Rather the second retraction member and second flexible elongated member work in conjunction with the first retraction member and first flexible elongated member. Without the second retraction member and second flexible elongated member, the recited integrated pet leash would be inoperable.

Moreover, the Examiner admits that Peterson '767 does not teach all of the recited elements. Thus, the issue here is distinguished from *St. Regis Paper* where all of the recited elements were present in the prior art and the patentee merely rearranged the well-known elements in a fashion that required the work of the skilful mechanic, not that of the inventor.

Given the failure of Peterson '767 to teach all of the recited elements, the Examiner relies upon the recited elements themselves in rejecting the claims as obvious. It is impermissible "to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.... To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires ... a motivation to combine the references that create the case of obviousness." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Yet, the Examiner has failed to identify a suggestion in the prior art to combine (or in this case add missing elements) in the manner recited in claims 1 and 13. This lack of a suggestion to combine renders the claims nonobvious.

Lastly, the nonobviousness of the claims 1 and 13 is demonstrated by secondary considerations. In particular, over a sixteen year span, Edwin Peterson, the inventor of US. Pat. No. 4,328,767, 4,964,370, and 5,816,198, made multiple attempts at creating a pet collar with a retractable leash. During the evolution of the Peterson collars, the retractor mechanism was first placed below the neck of the pet, however that collar had a number of problems. (See, Peterson '370 at col. 1, lines 9-21 (discussing failures of Peterson '767)) Further work by Peterson yielded an improved collar, but the improved collar suffered the same problem of having the retractor mechanism on the under side of the neck of the pet. This construction failed due to the retractor mechanism causing the collar to rotate around the neck of the pet. (See, Peterson '198

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at col. 1, lines 12-21 (discussing failures of Peterson '370)). After sixteen years, Mr. Peterson attempted to the rotation problem by adding a weight to the already heavy and cumbersome collar. (See, Peterson '198 at figure 1).

Thus, the series of Peterson patents demonstrates the long-felt need for an improved collar and multiple failed attempts at satisfying the need. (See Specification at ¶4) The present invention succeeds where Peterson failed by utilizing two retraction members and two elongated flexible members as recited in claims 1 and 13.

Turning to claims 2 and 14, and by dependence claims 3, 4, 11, 12, 15 and 16, these claims are allowable for the reasons described above with respect to claim 10.

Turning to claim 5, the Examiner contends it would have been obvious to construct the elongated members of steel wires. This reasoning is misplaced as it does not address the differences between leash 16 of Peterson '767 and the recited elongated members. As shown in figure 3 of Peterson '767, leash 16 is a wide nylon ribbon similar to a conventional pet leash and rolls up into retractor mechanism 15 when not in use. While it might have been obvious to use other materials such as leather, it would not have been obvious to use a significantly lighter and thinner material such as steel wire. The recited steel wire provides advantages unknown to Peterson '767 and only could have been implemented in Peterson '767 by applying hindsight as it is the recited steel wire that reduces the weight of the recited retraction members. Indeed, Peterson made various improvements to his pet collar over sixteen years, but did not change the construction of the leash. (See, Peterson '767, element 16; Peterson '370, element L; Peterson '198, element L)

#### **Conclusion**

Applicant respectfully submits that the pending claims are allowable, and respectfully requests a Notice of Allowance for this application. Should the Examiner believe that a telephone conference would expedite the prosecution of this application; the undersigned can be reached at the telephone number set out below.

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Please note that the undersigned attorney has changed correspondence address and telephone number. A change of address request for the attorney's customer number has been submitted.

Respectfully submitted,

DATE: March 18, 2005

  
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